

RESPONSE TO OFFICE ACTION

APPLICANT: Akira Osawa; SERIAL NO.: 09/293,509; AU: 3713

FILED: April 15, 1999; EXAMINER: White, C.; ATT'Y. DKT.: RM.HPN

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a secondary display for displaying an image, the image displayed by said secondary display being necessary for playing a secondary game that is different from the principal game, said secondary display displaying the image when the playing of the principal game results in one of a plurality of predetermined principal game playing states, the display of the image on said secondary display corresponding to a likelihood of winning the principal game.

In the Specification:

Page 26, line 14, delete "of" (first occurrence).

REMARKS

Amendments are presented herein to improve the form of the subject application and in response to the Examiner's comments in the above-identified Office Action.

Double Patenting

Claims 1-14 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of copending Application No. 09/268,960. The Examiner states that although the conflicting claims are not identical, they are not patentably distinct from each other because claims of the instant claimed invention are drawn to a gaming machine that has a primary game and a secondary game that achieves the same objective as the claimed invention of copending Application No. 09/268,960. The claim language of the instant application, according to the Examiner, is not exactly the same as that of Application No. 09/268,960. However, the invention of the instant application is considered by the Examiner to achieve all the same functions as the instant invention of Application No. 09/268,960. The Examiner states that this

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is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Applicant respectfully notes that he will provide, at such time as allowance herein is indicated, an appropriate Terminal Disclaimer that will address and overcome the Examiner's obviousness-type double patenting rejection.

Claim Rejections - 35 U.S.C. § 102(b)

Claims 1-8 and 14 stand rejected under 35 U.S.C. § 102(b) as specifying subject matter anticipated by United States Patent No. 5,393,057 (Marnell, II) or British Patent No. GB 2242300A (Farrell).

The Marnell, II reference describes a gaming apparatus that provides a principal game in the form of a slot machine game or a poker game. With each iteration of the principal game, such as a poker hand or stop action of a set of slot machine reels (column 2, line 47), an automatic entry is made into a secondary bingo (matrix) game (column 2, lines 49-50).

The Farrell reference describes a "fruit" machine (a slot machine with reels having fruit graphics thereon) with a second display in the form of a grid or matrix. The particular symbols that appear on the first or second reels when the reels are stopped are selectably presented in corresponding positions of the matrix. Prizes are awarded for completed lines in the matrix.

CLAIM 1

Regarding claim 1, the Marnell, II, or Farrell references are each considered by the Examiner to disclose a variable display for displaying graphical information corresponding to graphical elements necessary for a principal game; a controller for causing the variable display to display the graphical information; and a secondary display for displaying an image that is necessary for playing a secondary

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game that is different from the principal game, the secondary display displaying the image when the principal game results in one of a plurality of playing states (Marnell, II-col. 2, lines 35-51; col. 3, lines 1-9; Fig. 2; Farrell- Fig. 1; #57).

The Marnell, II and Farrell references are representative of the prior art arrangements discussed in the prior art section of the present specification. More particularly, these reference cause placement of a graphical symbol on the matrix-style secondary display in response to the particular symbol that is presented on the winning line of the principal game. In this regard, the present specification states at page 2, lines 5-23:

One known approach to alleviating the aforementioned problem of the gaming machine is to provide a gaming machine having a variable display and a further display, which such as a liquid crystal display or the like, by which a secondary game that is different from the principal game by the reels is played. One known approach employs a virtual race game wherein three kinds of special symbols are established for the principal game and three kinds of secondary images corresponding respectively to the three kinds of special symbols, respectively, are established for the secondary game. Whenever one of the special symbols stands on a winning line, the secondary image corresponding to that special symbol is moved on the liquid crystal display whereby it competes with the other secondary images. That is, the frequency of appearance of each special symbol causes its corresponding secondary image to move along the further display at a corresponding rate. The secondary images appear therefore to race, and when one of the secondary images reaches a predetermined position, the player wins an award.

In the known gaming machine described hereinabove, however, the secondary game proceeds simply when a special symbol of the principal game stands on the winning line. In other words, the secondary game proceeds with no relation to the result of the principal game. Accordingly, when a player endeavors to win the principal game, i.e., by the rotatable reels, the secondary game oftentimes proceeds without being noticed by the player. The player therefore does not achieve a sense of relationship between the principal game and the secondary game, and the player's enthusiasm to play to the gaming machine is not raised. (Emphasis Added)

In the present invention, however, the secondary game is related to the principal game, in that the playing of the secondary game will provide indication of the likelihood of winning the principal game. This is recited in the present specification at page 26, lines 6-15, as follows:

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As described above, the secondary game played on the secondary display screen is separate from the variable display that displays the principal game, but is related to the result of the principal game, thereby enhancing the player's interest in continuing to play the entire game. The secondary game by the secondary display screen proceeds while indicating histories of the (winning) states displayed in the past by the variable display. Therefore, the player can know whether the completion of the secondary game is near or not. Also, it is easy for the player to know at glance what kind of (winning) pattern has to be displayed in the principal game for completion of the secondary game so that the player may play the game with high interest and expectation. The player can endeavor to win of [sic] the principal game by paying attention to the progress of the secondary game, thereby greatly elevating the player's interest in the game. (Emphasis Added)

Not claimed → The Marnell, II and Farrell references do not teach or suggest any interrelationship between the principal and secondary games wherein the principal game can be won by reference to the secondary game. As previously noted, in each of the applied references, the result of the principal game is applied to cause an entry into a matrix game, but there is no teaching that the result of the matrix game can be applied to anticipate a win in the principal game. In the Farrell reference, the secondary display displays symbols that correspond to specific symbols that are present in the principal game when the reels of the principal game are stopped, not game states that correspond, for example, to winning states or to states that represent a determinable likelihood of winning. Moreover, the Marnell, II and Farrell references do not teach "a gaming machine wherein a player can earn a profit or receive an award that is increased in response to a secondary game that is played supplemental to a principal game." See, specification, page 3, lines 2-4.

- not claimed
then not claimed

With respect to independent claim 1, Applicant has amended this claim to specify subject matter that is neither taught nor suggested by the Marnell, II and Farrell references. More specifically, amended independent claim 1 specifies that there is provided:

...

a secondary display for displaying an image, the image displayed by said secondary display being necessary for playing a secondary game that is different from the principal game, said secondary display displaying the image when the playing of the principal game results in one of a

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plurality of predetermined principal game playing states, the display of the image on said secondary display corresponding to a likelihood of winning the principal game. (As amended)

Applicant respectfully notes that this amendment does not introduce new matter, and the subject matter that constitutes the amendment is amply supported in the present specification. In this regard, Applicant notes, for example, page 3, lines 17-21, of the specification, where it is stated that:

The predetermined state includes, for example, a predetermined display that is shown when the variation action (*e.g.*, the rotating reels) of the variable display is stopped. In other words, a predetermined winning combination of symbols (winning pattern) of the principal game and a combination of symbols (pattern) are predetermined to cause a particular symbol image to be shown on the secondary display.

As stated, the Marnell, II and Farrell references do not suggest that the image shown in the secondary display is indicative of a winning condition in the principal game, and therefore it is respectfully asserted that the Examiner's rejection of claim 1 has been overcome.

CLAIMS 2-4

Regarding claims 2-4, Marnell, II or Farrell are further considered by the Examiner to disclose the secondary display indicating symbol images that correspond to a respectively associated one of the principal game playing states. In this regard, the Examiner directs Applicants attention to Marnell II-abstract, and Farrell- Fig. 1, #6, #2; and #57.

Applicant respectfully notes in regard of this argument asserted by the Examiner that correspondence between the "principal game playing states" and the images displayed in the secondary display of the applied references do not correspond to the claimed "playing states." Contrary to the recitation set forth in amended independent claim 1, the secondary displays of the Marnell, II and Farrell references at best employ the symbol displayed in the principal game to further the playing of a grid (or matrix) secondary game. These known uses of secondary display images do

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not in any way advise the player of a winning state in the principal game, or of any other state in the principal game that relates to winning or losing the principal game. Clearly, therefore, the secondary images of the Marnell, II and Farrell references cannot even suggest that a winning or losing state in the principal game is imminent or likely.

CLAIMS 5-7

With respect to claims 5-7, the Marnell, II and Farrell references are considered by the Examiner further to disclose providing an award to a player when the secondary display screen satisfies a predetermined condition (Marnell II- col. 7, lines 7-14; Farrell- Fig. 1, #9 and page 9, lines 25-34).

The "predetermined condition" of the secondary display, which may, for example, constitute completion of a bingo line, may be compensable to the player, but is irrelevant to the likelihood of winning or losing the principal game.

CLAIM 8

With respect to claim 8, the Marnell, II and Farrell references are considered by the Examiner further to disclose the resetting of the secondary display (Marnell II- col. 7, lines 25-34 and col. 6, lines 23-27; Farrell- page 12, lines 20-25).

CLAIM 14

With respect to claim 14, the Marnell, II reference is considered by the Examiner to disclose the primary game being a slot game and a poker game (Fig. 1 and Fig. 2).

Applicant respectfully notes that the Examiner has applied only the Marnell, II and Farrell references against dependent claims 2-14. The applied references, in the combinations asserted by the Examiner, including the manner in which the references are applied against claims 2-7, hereinabove, do not add anything to the references as applied by the Examiner against amended

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independent claim 1. Accordingly, for the reasons stated hereinabove, it is respectfully asserted that the Examiner's rejection of claims 2-14 under 35 U.S.C. § 102(b), all of which depend from amended independent claim 1 and therefore contain all of the limitations therein, has been overcome.

Claim Rejections - 35 U.S.C. § 103(a)

Claims 9-12 stand rejected under 35 U.S.C. § 103(a) as specifying subject matter considered by the Examiner to be obvious over Marnell, II (5,393,057) or Farrell (GB 2242300A).

With respect to claims 9-12, Marnell, II or Farrell are considered by the Examiner to disclose all of the elements of the claims as discussed above. While Marnell II teaches the clearing of all of the display areas, the Examiner concedes that Marnell II is silent on disclosing the clearing of a single display area. Farrell is considered by the Examiner to disclose the resetting the display screen or the holding of some of the display areas for another game (p. 12, lines 20-30). However, the Examiner concludes that it would be an obvious design choice to clear either one or all areas according to whether or not the player wanted to maintain some symbol positions in order to increase the player's chances of winning in subsequent games. Therefore, the Examiner believes that it would have been obvious to include this feature in Marnell II or Farrell.

Claim 13 stands rejected under 35 U.S.C. § 103(a) as specifying subject matter considered by the Examiner to be obvious over Marnell, II (5,393,057) or Farrell (GB 2242300A) in view of Wilson, Jr. et al (6,004,207) or Adams (5,848,932).

Regarding claim 13, the Marnell II or Farrell references are considered by the Examiner to disclose all of the limitations of the claim, as discussed above. The Examiner concedes that Marnell II or Farrell lacks disclosure of a multiplied payout. The Examiner states, however, that in an analogous gaming machine, the Wilson, Jr., *et al.* or Adams references disclose the multiplication of

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a payout value (Wilson, Jr., *et al.*- abstract; Adams- abstract). The Examiner therefore concludes that it would have been obvious to a person of ordinary skill in the art at the time of the invention to include this feature in Marnell II or Farrell because it is well known in the art to provide multiplied payouts in slot machines to increase the players' interest in the game.

Applicant respectfully asserts that the Wilson, Jr., *et al.* or Adams references do not add anything to the combination of the Marnell II or Farrell references that would render the foregoing arguments and amendments in support of the patentability of amended independent claim 1 not to be persuasive. The Wilson, Jr., *et al.* reference describes, as suggested by the Examiner, a payout multiplier that gradually increases with time, so as to entice the player to continue to play the principal (or base) game. The Wilson, Jr., *et al.* reference does not describe a system with a secondary game, and the payout multiplier does not provide any indication of the likelihood of winning or losing the principal game. Accordingly, this reference does not teach or suggest the invention specified in amended independent claim 1.

The Adams reference also describes, as suggested by the Examiner, a payout multiplier that provides at least one of a plurality of payouts. This reference does not describe a system with a secondary game, and the payout multiplier does not provide any indication of the likelihood of winning or losing the principal game. Accordingly, this reference does not teach or suggest the invention specified in amended independent claim 1.

In view of the foregoing, it is respectfully asserted that the Wilson, Jr., *et al.* and Adams references, as applied against claims 9-13, do not add anything to the combination of the Marnell II or Farrell references that would render the arguments and amendments hereinabove in support of the patentability of amended independent claim 1 not to be persuasive. Claims 9-13, which are subject

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to the Examiner's rejection under 35 U.S.C. § 103(a), all depend from amended independent claim 1 and therefore contain all of the limitations therein. Accordingly, it is believed that the Examiner's rejection of claims 9-13 under 35 U.S.C. § 103(a) has been overcome.

Citation of Pertinent Prior Art

The prior art made of record and not relied upon is considered by the Examiner to be pertinent to Applicant's disclosure. The following references are identified by the Examiner as disclosing gaming machines with primary and secondary game features:

Barrie	(US 5,980,384)
Fraley	(US 4,712,799)
Weiss	(US 5,772,509)
Wain	(GB 2222712A)
Sunaga	(US 5,984,781)
Vancura	(US 6,033,307)

Applicant has studied the prior art references that were cited by the Examiner but not applied against the claims and has determined that these references, irrespective of whether they are viewed singularly or in combination with any other reference of record do not teach or suggest the claimed invention.

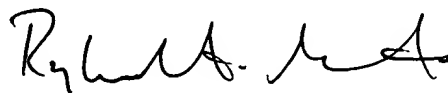
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In view of the foregoing, it is respectfully requested that the Examiner reconsider the present application, allow the claims, and pass the application for issue. If the Examiner believes that the prosecution of this case can be expedited by a telephone interview, the Examiner is requested to call attorney for Applicant at the telephone number indicated hereinbelow.

Respectfully submitted,



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